

REMARKS

I. Status of the Application

Claims 1-20 are pending in this application. In the July 30, 2004 Office action, the examiner noted that Figure 1 of the drawings should be amended. The examiner also objected to the specification because of various informalities related to the reference numerals. In addition, the examiner rejected claims 1-3 and 8-16 under 35 U.S.C. § 103(b) as allegedly being obvious over U.S. patent No. 6,019,225 to Kalmakis et al (“Kalmakis”) in view of U.S. Patent No. 5,190,727 to Hirsh (“Hirsh”) and further in view of U.S. patent No. 6,015,064 to Liu (“Liu”). Finally, the examiner objected to claims 4-7 and 17-20 as being dependent upon a rejected base claim, but noted that claims 4-7 and 17-20 would be allowable if re-written in independent form.

In this response, applicants have proposed a drawing correction and amended the specification to correct the informalities noted by the examiner. With respect to the claims, applicants traverse the examiner’s rejection of claims 1-3 and 8-16. Finally, applicants have added new claims 21-31.

II. The Objection to the Drawings Should be Withdrawn

In the July 30, 2004 office action, the examiner noted that Figure 1 of the drawings should be designated by a legend such as “Prior Art” pursuant to MPEP § 608.02(g). Attached hereto is a replacement sheet of drawings which shows revised Figure 1 including the legend “Prior Art”. The attached replacement sheet is labeled “Replacement Sheet” in the header, pursuant to 37 CFR § 1.121.

III. The Objection to the Specification Should be Withdrawn

In the July 30, 2004 Office action, the examiner objected to the specification because of various informalities. In particular, on pages 2-3 of the specification, the tips are designated as reference numerals 20 and 30. Applicants have amended the specification such that the tips are correctly designated as reference numeral 30 on page 2 of the specification.

IV. The Rejection of Claims 1-3 and 8-16 should be Withdrawn

In the July 30, 2004 Office action, the examiner rejected claims 1-3 and 8-16 under 35 U.S.C. § 103(a) as being obvious and unpatentable over Kalmakis in view of Hirsh and further in view of Liu. Applicants respectfully traverse the examiner's rejection of claims 1, 8 and 13 under 35 U.S.C. § 103(a), as the examiner has failed to make a *prima facie* case of obviousness as described in MPEP § 2142 - 2143.

A. There Must Be a Basis in the Art for Combining the References

In order to establish a *prima facie* case of obviousness, there must be some suggestion or motivation to combine the reference teachings. MPEP § 2143. A motivation to combine references is required to "prevent the use of hindsight based on the invention to defeat patentability of the invention." See In re Rouffet, 149 F.3d 1350 (Fed. Cir. 1998). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680 (Fed. Cir. 1990).

1. Hirsch

In the July 30, 2004 Office action, the examiner provided the following argument as a motivation to combine Hirsch with Kalmakis: “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to recognize as taught by Hirsch when components of a pipetting device are frictionally engaged and disengaged (as in the attachment and detachment of pipette tips) an active static charge may develop on the components.” However, contrary to the examiner’s position, frictional engagement and disengagement of the components of a pipetting device is not taught by Hirsch.

With general reference to columns 3 and 4 of Hirsch, Hirsch discloses placement of pipette trays 32 onto driven belts 16 that move along a guide trough 14. Movement of each tray 32 and its associated pipettes 31 is stopped when the pipettes 31 in the tray abut a stop member 23 mounted within the guide trough 14. The stop member 23 comprises an electrically conductive material and is connected to ground through the rest of the apparatus. The stop member 23 functions to discharge electrostatic charges that build up in the tray 32 as the belt continues to push the tray and pipette against the stop member (see Col. 3, lines 44-58). Accordingly, Hirsch teaches removal of electrostatic charge build up in a pipette tray when a moving transport belt slides against the tray. Hirsch makes no mention of electrostatic charges created by frictional engagement and disengagement of a tray and pipette tips.

Because Hirsch deals with electrostatic build up created from frictional engagement of a tray and a transport belt, the examiner has provided no motivation to combine Kalmakis and Hirsch. In particular, the examiner has not provided sufficient basis from the cited references to explain why one of skill in the art would think to

combine Kalmakis and Hirsch. Specifically, nowhere does Kalmakis suggest a concern related to electrostatic build-up created by the rack sliding relative to a transport belt. Therefore, the examiner's stated motivation for combining the references is insufficient.

2. Liu

In the July 30, 2004 Office action, the examiner provided the following argument as a motivation to combine Kalmakis and Liu: "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device of Kalmakis by manufacturing the device from an electrically conductive plastic material in order to remove a charge from the pipette tip stored in the rack or to prevent a charge from building up in the container."

It is not enough for the examiner to merely state that it would have been obvious to one of ordinary skill in the art to modify the device of Kalmakis with the plastic material of Liu, the examiner must provide support or an explanation for this conclusion. See MPEP § 2143.01, discussing In re Fine, 837 F.2d 1071 (Fed. Cir. 1988). Applicants respectfully submit that no such support is found in the motivation provided by the examiner for combining Kalmakis and Liu.

As set forth above, the examiner has relied on the teachings of the cited prior art as the motivation to combine Kalmakis, Hirsch and Liu. However, the prior art cited by the examiner provides no such motivation to combine the cited references. Accordingly, it is respectfully submitted that the examiner has failed to make a prima facie case of obviousness, and the rejection of claims 1-3 and 8-16 under 35 U.S.C § 103(a) should be withdrawn.

B. The Prior Art Teaches Away

When the prior art teaches away from the claimed invention, there is a suggestion of a lack of *prima facie* obviousness. MPEP § 2145; See In re Fine, 873 F. 2d 1071 (Fed. Cir. 1988). In the present case, the examiner has combined Kalmakis, Hirsch and Liu. As discussed previously, Hirsch discloses pipettes held by a rack that moves and slides upon a belt. The pipettes in Hirsch contact a stop member in a guide trough. The stop member is comprised of an electrically conductive material and is connected to ground. In this manner, the stop member functions to discharge electrostatic charges that build up in the tray as the belt forces the tray and pipettes against the stop member.

As set forth in the preceding paragraph, the prior art cited by the examiner as operable to discharge electrostatic charges (i.e., Hirsch) generally teaches the use of a conductive outside component that is separate from a pipette tray, i.e., a conductive stop member, to contact pipette tips and discharge electrostatic charges. Use of such a conductive outside component, in addition to the tray and not connected to the tray, for the purposes of contacting the pipette tips and discharging electrostatic forces from the tips teaches away from the claimed invention. Accordingly, because the prior art teaches away from the claimed invention, it is respectfully submitted that the examiner has failed to make a *prima facie* case of obviousness, and the rejection of claims 1-3 and 8-16 under 35 U.S.C § 103(a) should be withdrawn.

C. Hirsch is Non-analogous Prior Art

In order to rely on a reference under 35 U.S.C. § 103, the reference must be analogous prior art. MPEP § 2141.01(a). The determination that a reference is from a

non-analogous art is twofold. First, it must be decided if the reference is within the field of the applicant's endeavor. Second, if it is not, it must be determined whether the reference is reasonably pertinent to the particular problem with which the applicant was involved. Id.; In re Wood, 599 F.2d 1032 (CCPA 1979).

First, Liu relates to the field of hand-portable plastic closeable, re-sealable containers for storing multiple pieces of different objects. The present invention, on the other hand, relates to pipette tip racks. Accordingly, the field of Liu is not within the field of the applicant's endeavor.

Second, Liu is not pertinent to the particular problem with which applicant was involved. Applicant's problem, as set forth in the background section of the application, involves polypropylene tips being returned to the tip rack with electrostatic charges created from rubbing action between the tips and the pipettes, and the need for dissipation of such charges. Conversely, conductive plastic storage containers for electronic components, as disclosed in Liu, are not concerned with dissipation of electro-static charges on the objects delivered to the containers. Instead, electronic component storage containers are designed to prevent electrostatic charge from being transferred to the electronic components during storage, as such electrostatic charges may be harmful to the electronic components. Although both problems involve electrostatic charges, the problems are unrelated, as one problem involves dissipation of electrostatic charge and the other problem involves preventing electrostatic charge from contacting or forming on a component in the first place. Accordingly, because Liu is non-analogous prior art, it is respectfully submitted that the examiner has failed to make a prima facie case of obviousness, and the rejection of claims 1-3 and 8-16 under 35 U.S.C § 103(a) should be

withdrawn.

V. Conclusion

For all of the foregoing reasons, it is respectfully submitted that the examiner has not made a *prima facie* case of obviousness, and the applicant has made a patentable contribution to the art. Favorable reconsideration and allowance of this application, including original claims 1-20 and new claims 21-31, is therefore respectfully requested.

Applicant has included a check in the amount of \$286.00 in payment of new claims 21-31. In the event applicant has inadvertently overlooked the need for an extension of time or payment of an additional fee, the applicant conditionally petitions therefore, and authorizes any fee deficiency to be charged to deposit account 13-0014.

Respectfully submitted,



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Enclosures: Drawing Replacement Sheet
Check in the amount of \$286.00

cc: Mr. D. David Hill